

Remarks

Applicants thank the Examiner for the courtesies extended to the undersigned during the telephone interview. An Interview Summary accompanies this response.

Applicants hereby add claims 27-34. Accordingly, claims 1-6, 8-15, and 17-34 are pending in the present application.

Claims 1-3, 5-6, 8-9, 12, 15, and 17-26 stand rejected under 35 USC 102(e) for anticipation over U.S. Patent No. 6,519,470 to Rydbeck. Claims 4, 10-11, 13-14, and 15-26 stand rejected under 35 USC 103(a) for obviousness over Rydbeck.

Applicants respectfully request reconsideration of the rejections.

Referring to the objection to the drawings, Applicants submit a new Fig. 1 herewith which includes changes discussed during the interview. In particular, Applicants have added search language to box 6 of Fig. 1 and added generate language to boxes 16, 20 as discussed during the interview. Also, Applicants amended the preambles of the claims pursuant to the discussion. Applicants submit the amendments to Fig. 1 to provide conformance of the drawings with the originally-filed specification and claims in accordance with MPEP 2163.06 (8th ed., rev. 3) which provides that information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without adding new matter. Applicants submit that Figs. 1 and 2 show the features of the invention specified in the claims in accordance with 37 CFR 1.83(a). Also, Applicants assert that the drawings do not include excessive text and comply with MPEP 507 (8th ed., rev. 3) and 37 CFR 1.84(o). The Examiner agreed with the proposed changes during the interview and stated during the interview that he would let Applicants know if he recommends any additional changes to the drawings. Applicants appreciate the assistance of the Examiner in this regard.

With respect to the indefiniteness rejections, the undersigned and the Examiner discussed the allegation in paragraph 4 on page 3 of the Office Action that the method is missing "an essential step" of the occurrence of the warranty start event. In response, Applicants' position is that the claim 1 invention is not positively claiming the occurrence of the warranty start event but rather the generating is after the detection of the occurrence of the warranty start event in

accordance with Applicants' right to claim their invention as they choose. "A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers [and] [t]hey can define in the claims what they regard as their invention essentially in whatever terms they choose...." MPEP §2173.01 (8th ed., rev. 3). The Office did not point to any evidence of record that Applicants' consider the "occurrence" to be essential. Applicants respectfully request a telephone call if the Examiner disagrees with this position.

Referring to the 112 rejection at paragraph 5 of the Office Action, Applicants have amended claim 1 and believe the claim is definite. The amendment to the preamble of the claims renders moot the alleged 112 rejection set forth in paragraphs 6 and 9 of the Action. Further, Applicants have not stated that the formerly claimed determining is essential. Referring to the 112 rejection in paragraph 7 of the Action, Applicants have amended "network" to be "data network" for consistency. Referring to paragraph 8 of the Action, Appellants have amended claim 12 for clarification.

The amendments made herein with respect to 112, second paragraph, now more positively express limitations which were previously inherent in such claim(s), and accordingly are not for the purpose of narrowing and do not effectively narrow the scope of any claim.

Referring to the anticipation rejections, Applicant notes the requirements of MPEP §2131 (8th ed., rev. 3), which states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The **identical invention** must be shown in as complete detail in the prior art as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). **The elements of the prior art must be arranged as required by the claim.** *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The method of claim 1 recites the product is for producing output, and wherein said warranty start event comprises *production of a specified quantity of the output*. The Office alleges at page 5 of the Action that for a phone, the first use is considered to be output. Applicants respectfully submit the teachings of Rydbeck fail to teach or suggest the claimed limitations and the 102 rejection is improper for at least this reason.

Rydbeck teaches automated warranty registration for communications

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devices as stated at col. 3, lines 12+. Applicants assert that the "first use" of Rydbeck is not related to *producing any output* as claimed. As set forth in col. 3, lines 5+ and col. 4, lines 17+ of Rydbeck, the mere turning of the device on initiates the warranty registration process including the generation of the timestamp within the warranty registration center 19. The mere turning on of the device to start the automated warranty process of Rydbeck may not be fairly interpreted to disclose the claimed warranty start event comprising production of a specified quantity of output. In addition, the warranty registration procedure of Rydbeck is merely in response to turning the phone on and not in response to any use of the phone (i.e., making a call). Further, claim 1 recites the warranty start event comprises production of a specified quantity of output and not "first use" or turning the device on. Positively-recited limitations of claim 1 are not disclosed nor suggested by the prior art and claim 1 is allowable for at least this reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 3, Applicants respectfully submit the Examiner has improperly combined the teachings of the invention of Rydbeck with the teachings of prior art devices which the invention of Rydbeck has improved upon in support of the rejection. In particular, the Examiner relies upon the teachings of the invention of Rydbeck as discussed in the Detailed Description section as allegedly teaching the limitations of independent claim 1. However, the Examiner relies upon the teachings in col. 2 of Rydbeck referring to a *prior art device* which stores a start-of-service date in internal memory of the prior art device. However, as is clear from lines 6+ of col. 2, the prior art teachings of using the internal storage is deemed unacceptable to the invention of Rydbeck for the clear reasons set forth in col. 2 and Rydbeck discloses an explicit arrangement of the center 19 providing the time stamp with the identification per col. 7, lines 39+. There is no teaching of combining the prior art teachings of col. 2 with the teachings of the Rydbeck invention of the Detailed Description. To the contrary, Rydbeck makes clear the disparate teachings are not to be combined. The device of the invention of Rydbeck relied upon to reject claim 1 is clearly taught in

Rydbeck to not store the timestamp internally of the phone and to the contrary all storage of the timestamp is in the remote device of the center 19. Limitations of claim 3 are not disclosed nor suggested by the prior art and claim 3 is allowable for at least this reason.

Referring to claim 4, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 3).

Claim 4 recites that the *generating the timestamp comprises obtaining the timestamp from a clock internal to the product*. Rydbeck teaches away from the claimed invention by having the center 19 provide all timestamp operations at step 640 of Fig. 5 of Rydbeck as opposed to the phones 16. Rydbeck has no need for phones 16 to generate the timestamp due to the problems clearly identified at col. 2. The teaching away of Rydbeck from Applicants' claim 4 invention is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is a *per se* demonstration of lack of obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). There is no motivation to combine or modify Rydbeck in a manner clearly contrary to the invention of Rydbeck and the Office has failed to establish a proper 103 rejection for at least this reason.

In addition, the undersigned hereby traverses and seasonably challenges any reliance upon Official Notice pursuant to MPEP §2144.03 (8th ed., rev. 3), and requests the Examiner cite a reference or affidavit in support of his or her position in a non-final Action if claim 4 is not allowed.

MPEP 2144.03A (8th ed., rev. 3) provides that *official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known*. It is not appropriate for the Office to take official notice of facts without a reference where the facts asserted to be well known are not capable of instant and unquestionable

demonstration as being well-known.

The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. See *In re Eynde*, 480F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). The Examiner is also reminded that claims are analyzed in the context of the combination of the various separately stated limitations of the claimed invention as a whole, and not with respect to the limitations individually. MPEP 2141.02I (8th ed., rev. 3). Pursuant to MPEP §2144.03 (8th ed., rev. 3), Applicant hereby demands evidence with respect to what the Examiner apparently relies upon as being "well-known." Applicants submit the combination of limitations are not well known and their reliance upon judicial notice is improper inasmuch as the modification is contrary to the explicit teachings of Rydbeck in col. 2.

MPEP 2144.03A (8th ed., rev. 3) provides that *official notice is proper when the facts are capable of instant and unquestionable demonstration as to defy dispute*. MPEP 2144.03A gives examples of limitations which are considered well known, such as when new audio information is recorded then the old information is erased, or when a heat requirement is varied it is well known to vary a flame. The MPEP states that Official Notice is proper when the *teachings are readily verifiable* (e.g., use of a control in bacteriology). MPEP 2144.03B (8th ed., rev. 3). MPEP 2144.03A and 2144.04E make clear that *Official Notice is proper with respect to facts which are of notorious character and serve only to fill in the gaps in an insubstantial manner*.

Even if it is found that the claimed limitations individually are well known (as is not proper for the reasons above), such taking of Official Notice is still contrary to the explicit teachings of Rydbeck providing timestamp operations by center 19 to avoid the clear problems set forth in col. 2.

Applicants submit the Office has failed to establish a proper *prima facie* 103 rejection and improperly relied upon judicial notice and claim 4 is allowable.

Referring to claim 8, the method recites *obtaining a timestamp over a data network*. At col. 7, lines 39+ of Rydbeck, it is disclosed that the timestamp is recorded and stored within memory of center 19. There is no teaching of obtaining a timestamp over a data network as positively claimed. The teachings in col. 5,

lines 20-37 relied upon by the Examiner refer to general communications and fail to disclose a timestamp. The teachings in col. 7, lines 59-69 merely disclose that the database is used to determine the start date void of obtaining the timestamp over a data network. Claim 8 is allowable for this additional reason.

Claims 10-11 recite *encrypting the timestamp*. The Office states that such claims are obvious over Rydbeck. The Office baldly alleges that encryption of a stamp is old and well established. Applicants again traverse the reliance upon judicial notice and there is no motivation to modify Rydbeck to arrive at the claim limitations. In particular, Rydbeck does not disclose communication of the timestamp and accordingly there is no need for encryption. The Office has failed to provide any explanation as to why one would be motivated to modify Rydbeck to provide encryption of the timestamp and the 103 rejection is improper for at least this reason. Furthermore, with respect to the reliance upon judicial notice, claims are analyzed in the context of the combination of the various separately stated limitations of the claimed invention as a whole, and not with respect to the limitations individually. MPEP 2141.02I (8th ed., rev. 3). Applicants submit there is no evidence that encrypting data in combination of limitations of claims 10-11 is old and well established. Applicants respectfully request allowance of claims 10-11 in the next Action.

Referring to independent claim 13, the Office relies upon turning the phone of Rydbeck on as teaching the defining the warranty start event. However, claim 13 recites *defining the warranty start event comprising production of a specified amount of output*. Applicants assert that the turning the phone on of Rydbeck to start the warranty registration process does not disclose *production of a specified amount of output* as claimed. As set forth in col. 3, lines 5+ and col. 4, lines 17+ of Rydbeck, the mere turning of the device on initiates the warranty registration process. The mere turning on of the device to start the automated warranty process of Rydbeck is not related to any calls or other output and may not be fairly interpreted to disclose the claimed warranty start event comprising production of a specified quantity of output as claimed. Positively-recited limitations of claim 13 are not disclosed nor suggested by the prior art and claim 13 is allowable for at least this reason.

Claim 13 also recites *searching for occurrence of said warranty start event*.

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The Office has failed to identify teachings which allegedly teach the claimed searching of claim 13. As mentioned above, the mere turning on of the phone of Rydbeck starts the warranty process. Accordingly, prior to being turned on, the phone is off and is not disclosed as being capable of any searching as claimed. The claimed searching is not disclosed nor suggested by the prior art and claim 13 is allowable for at least this additional reason.

In addition, Rydbeck provides at col., 7, lines 39+ that the unique identifier is recorded with a date stamp. The Office has failed to identify any teachings of the claimed *querying the timeserver connected to the network for the time value*. The teachings in col. 5, lines 25-35 of Rydbeck fail to teach or suggest the claimed querying the timeserver. The rejection of claim 13 is improper for this additional reason.

There is no motivation to modify Rydbeck to provide encryption of the timestamp and the teachings of the prior art of col. 2 are not applicable to the invention of Rydbeck and the claimed storing the timestamp in the printer is not taught by the prior art. There are no teachings of the claimed outputting of the timestamp from the printer. Numerous limitations of claim 13 are not disclosed nor suggested by the prior art and claim 13 is allowable for at least these reasons.

The claims which depend from independent claim 13 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to dependent claim 14, Applicants traverse any reliance upon judicial notice in support of the rejection as apparently made on pages 8-9 of the Action. Rydbeck teaches the warranty registration procedure beginning responsive to the phone being turned on and not responsive to the implementing of a phone call. The claimed limitations of the warranty start event comprising *production of a specified number of documents* is not demonstrated to be well known by the teaching of Rydbeck of starting the warranty registration process by turning a phone on. In addition, the turning of the phone on to start the process cannot be fairly interpreted to teach the claimed warranty start event comprising production of a specified number of documents as claimed. Applicants traverse any reliance upon the limitations being well known and the claim 14 is allowable inasmuch as the

warranty start event comprising production of a specified number of documents is not disclosed nor suggested in the art. Applicants also traverse any reliance upon judicial notice in support of the rejections of claims 19, 21 and 25.

Referring to independent claim 15, the Office has failed to identify any teachings which allegedly disclosed the claimed *retrieval by the product of the stored warranty event definition from a memory*. To the contrary, Rydbeck merely discloses the turning of the phone on starts the warranty registration process. The retrieval is not disclosed nor suggested by the prior art and claim 15 is allowable for at least this reason.

The timestamp operations of Rydbeck are performed using the center 19 and the limitations of generating the timestamp using the product are not disclosed nor suggested by the prior art. Furthermore, even if the teachings of the prior art device of col. 2 of Rydbeck are combined with the invention of Rydbeck as described in the Detailed Description, the combination fails to disclose or suggest the claimed generation of the timestamp comprises causing the product to obtain a current time value over the network. Furthermore, the phone of Rydbeck is not configured to obtain the current time value over the network as claimed. Claim 15 is allowable for at least these reasons.

The claims which depend from independent claim 15 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 19, the phone of Rydbeck may not be fairly interpreted to teach or suggest the claimed *product for producing units of output* as claimed. Claim 19 is allowable for at least this reason. Furthermore, the turning of the phone on in Rydbeck is used to start the warranty processes. The mere turning of the device on fails to teach or suggest the claimed warranty start event comprises production of a specified number of units of output as claimed. Claim 19 is allowable for this additional reason.

Referring to claim 20, the phone of Rydbeck may not be fairly interpreted as teaching the claimed *document production apparatus for producing documents* as defined. Claim 20 is allowable for at least this reason. Rydbeck also fails to teach output of said timestamp comprising causing the product to output a diagnostic test

document comprising said encrypted timestamp. Claim 20 is allowable.

Referring to independent claim 21, the warranty start event definition comprising production of a specified cumulative number of documents is not taught by the prior art. The prior art also fails to teach the claimed memory internal to the peripheral. Rydbeck fails to disclose the claimed search for occurrence of the warranty start event or obtaining the timestamp over the network using the peripheral as claimed. There is no teaching of the claimed encryption of the timestamp, storage of the timestamp in the memory of the peripheral or the outputting of the encrypted timestamp on a document using the peripheral. Claim 21 is allowable for these numerous reasons.

Referring to independent claim 22, there is no teaching or suggestion in the prior art of the claimed generating the timestamp comprising obtaining the timestamp over the network. Claim 22 is allowable for at least this reason.

Referring to independent claim 23, Rydbeck fails to disclose or suggest the claimed generating the timestamp using the product and claim 23 is allowable for at least this reason.

Referring to independent claim 24, Rydbeck fails to disclose or suggest the claimed causing the product to retrieve the stored warranty start event definition from memory, causing the product to generate the timestamp, or the causing the product to store the timestamp in memory remote from the product and claim 24 is allowable for at least this reason.

Referring to independent claim 25, Rydbeck fails to disclose or suggest the claimed causing the product to retrieve the stored warranty start event definition from memory, causing the product to generate the timestamp, causing the product to store the timestamp in memory, or causing the product to output the timestamp. The prior art also fails to disclose or suggest the product is for producing units of output and the warranty start event comprises production of a specified number of units of output as claimed. Claim 25 is allowable for at least this reason.

Referring to independent claim 26, Rydbeck fails to disclose or suggest the claimed causing the product to retrieve the stored warranty start event definition from memory, causing the product to generate the timestamp, causing the product to store the timestamp in memory, or causing the product to output the timestamp. The phone of Rydbeck may not be fairly interpreted as teaching the claimed

document production apparatus for producing documents as defined. Rydbeck fails to teach the claimed causing the product to output a diagnostic test document comprising said encrypted timestamp. Claim 26 is allowable for these reasons.


Applicants hereby add new claims 27-32 which are supported at least by Fig. 1 and the associated teachings of the specification.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
Theresa A. Burkes et al.

By:



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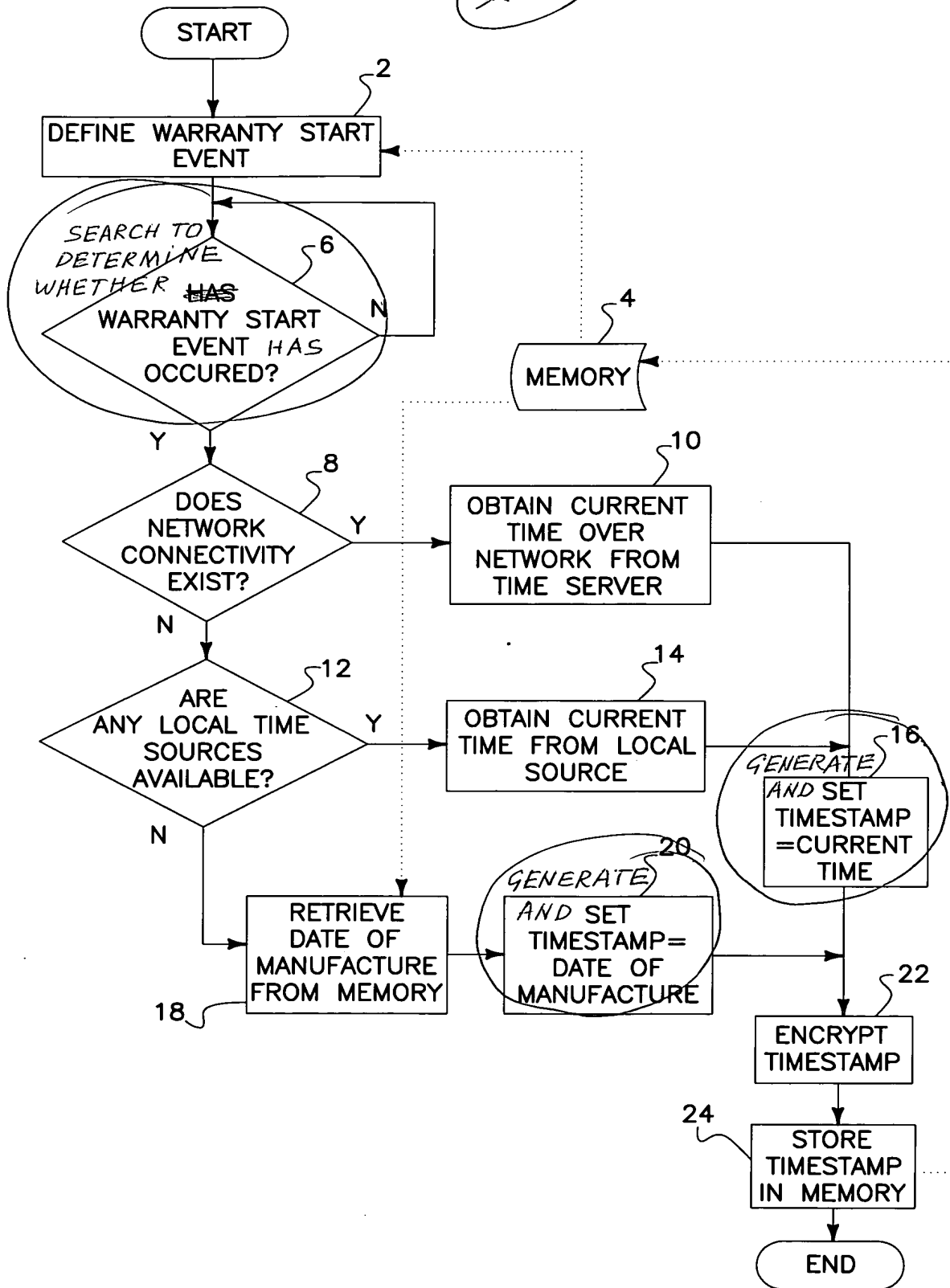


FIG.1